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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,121	07/13/2001	Mathieu Joanicot	RN95059D2	9393

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EXAMINER	
REDDICK, MARIE L	
ART UNIT	PAPER NUMBER
1713	8

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/905,121	JOANICOT ET AL.	
	Examiner	Art Unit	
	Judy M. Reddick	1713	

-- The MAILING DATE of this communication appears on the cov r sheet with the correspond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07/13/01;05/27/03;09/29/03*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *45-55,61 and 62* is/are pending in the application.

4a) Of the above claim(s) *52-55* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *45-51,61 and 62* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 07/13/01 has been considered and placed in the application file.

Election/Restrictions

2. Claims 52-55 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 7.

Specification

3. The abstract of the disclosure is objected to because there is no nexus seen between "1.5 milliequivalents/gram." and "Application to paint.". Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 45-51, 61 and 62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) The recited "between 0.3 and 1.5 milliequivalents/gram" per claim 45 constitutes indefinite subject matter as per the entity that said content is being based on is not readily ascertainable, i.e., solid matter(the same as the content basis for the "accessible acidic functional group") or else.

B) The recited "said composition comprising a population B of particles bearing isocyanate functional group(s)" per claim 45 constitutes indefinite subject matter as per said language engendering an awkward nexus between the "population B of particles bearing isocyanate functional group(s) and the "composition comprising a population A of latex particles".

C) Claims 50 and 51 constitute indefinite subject matter as per it not being readily ascertainable as to how said claims differentiate over one another.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 45-51, 61 & 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uemae et al(U.S. 5,405,879).

Uemae et al disclose and exemplify aqueous coating compositions, applied to a variety of substrates, defined basically as containing an aqueous dispersion of acrylic polymer particles governed by a particle size of 0.05 to 0.5 microns and comprising a core/skin wherein the skin is built up from monomers M-1 to M-4 which include alpha, beta-unsaturated mono- or dicarboxylic acids and hydroxyalkyl(meth)acrylates, crosslinking agents which include isocyanate compounds and other conventional adjutants such as pigments, dispersants, etc. See, e.g., the Abstract, cols. 3-14 and the Runs of Uemae et al and especially col. 5, lines 44-51 and col. 12, lines 40-68 and col. 13, lines 1-35 of Uemae et al.

The disclosure of Uemae eat al differs basically from the claimed invention as per the non-express disclosure of an embodiment directed to the specifically claimed acidic and hydroxy-functional-governed latex polymer particle. However, one having ordinary skill in the art would have found it obvious to extrapolate the specific latex polymer particle from Uemae et al as per such having been within the purview of the general disclosure of Uemae et al and with a reasonable expectation of success. Criticality for such, clearly commensurate in scope with the claims, not having been demonstrated on this record.

As to the dependent claims, the limitations are either taught by Uemae et al, suggested by Uemae et al or would have been obvious to the skilled artisan and with a reasonable expectation of success.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for

purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 45-51, 61 & 62 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Takeuchi et al(U.S. 5,453,458).

Takeuchi et al disclose and exemplify compositions, useful as protective coatings for automobile surfaces, defined basically as containing a core/shell polymer latex, governed by a weight-averaged particle size of 0.1 to 50 micrometers, wherein the shell is built up from 25-95 wt.% of an aromatic vinyl monomer, 5-40 wt.% of alpha, beta-ethylenically unsaturated carboxylic acids and/or hydroxyalkyl esters of alpha, beta-ethylenically unsaturated carboxylic acid and 0-70 wt.% of other comonomer(s), a crosslinking agent which includes an isocyanate compound, a plasticizer and other conventional adjuvants such as pigments, etc. See, e.g., the Abstract, cols. 4-9 and the Runs and especially col. 4, lines 21-40, col. 5, lines 15-54 and col. 8, lines 35-57 of Takeuchi et al. Takeuchi et al therefore anticipate the instantly claimed invention.

It is the base presumption that the claimed properties, if not taught, would be met by the aqueous dispersion of Takeuchi et al as per the aqueous dispersions of Takeuchi et al are essentially the same as and made in essentially the manner as applicants' latex polymer particles. Consult Best et al(195 USPQ 430).

Even if it turns out that the claims are not anticipated then, it would have been obvious to the skilled artisan to extrapolate, from the disclosure of Takeuchi et al, the instantly claimed

composition having a population A of latex particles and a population B of particles bearing isocyanate functional group(s) and with a reasonable expectation of success.

As to the dependent claims, the limitations are either taught by Takeuchi et al, suggested by Takeuchi et al or would have been obvious to the skilled artisan and with a reasonable expectation of success.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR
12.01.03